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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,281

09/26/2003

Hirotooshi Fujisawa

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RADER FISHMAN & GRAUER PLLC  
LION BUILDING  
1233 20TH STREET N.W., SUITE 501  
WASHINGTON, DC 20036

EXAMINER

SHAN, APRIL YING

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

07/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/670,281

Applicant(s)

FUJISAWA, HIROTOSHI

Examiner

April Y. Shan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. The Applicant's amendment, filed 27 April 2007, has been received, entered into the record, respectfully and fully considered.
2. As a result of the amendment, claims 6, 10 and 18 have been amended. Claims 1-18 are now presented for examination.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per amended **claims 10 and 18**, "a computer readable-medium" is being recited. The examiner carefully and respectfully reviewed the original disclosure, the Applicant discloses "a recording medium" in par. [0199]. A computer readable medium is different than recoding medium of the spec. A reasonable interpretation is that computer readable medium includes transmission medium i.e. signals (not statutory).

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 10 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 10 and 18** are directed to a computer program product stored on a computer readable medium. The examiner respectfully and carefully reviewed the original disclosure and "computer readable medium" is not disclosed in the original disclosure. To a person with ordinary skill in the art, it is a reasonable interpretation that computer readable medium includes both recording medium (statutory) and transmission medium i.e. signals, carrier wave and etc. (not statutory). Transmission medium is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Pare, Jr. et al. (U.S. Patent No. 6,662,166)

As per **claims 1-4, 9, 11-12 and 17**, Pare, Jr. et al. discloses an information management system/method comprising:

an information management apparatus ("Party Identification Apparatus (PIA)" in fig. 1, 3, 7) for producing an authentication image to be used to authenticate a user ("the payor submits a bid biometric sample obtained from their physical person by the PIA's biometric sensor. The PIA determines that the biometric sample is non-fraudulent, and then translates and compresses that biometric sample into a format suitable for rapid transmission to the DPC" – e.g. col. 15, lines 26-31), and an information processing terminal ("an integrated LCD screen 14" in fig. 1) for displaying the authentication image provided by the information management apparatus ("information such as the amount of a transaction, the identity of a payee, the list of credit/debit accounts for a payor to

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select from, or other transaction-related information is displayed using an integrated LCD screen 14..." – e.g. col. 8, line 64 – col. 9, line 2. Please note the list of credit/debit accounts for a payor to select from corresponds to Applicant's the authentication image since Pare Jr. et al. discloses in col. 15, lines 35-39, "the DPC identifies the payor, and retrieves the list of credit/debit accounts that the payor has previously registered with the system and then displays on the screen".), wherein the information management apparatus comprises:

generating means for generating a first authentication image based on a predetermined original image ("the payor submits a bid biometric sample obtained from their physical person by the PIA's biometric sensor. The PIA determines that the biometric sample is non-fraudulent, and then translates and compresses that biometric sample into a format suitable for rapid transmission to the DPC" – e.g. col. 15, lines 26-31 and please see below examiner's response to arguments item 11),

authenticating means ("Data Processing Center 22" in fig. 4) for authenticating the first authentication image which is provided by the information processing terminal through a control device that controls the reading of an image displayed on the information processing terminal ("...the PIA transmits the biometric or biometric-PIN to the DPC for identification,...The DPC identifies the payor using the biometric sample, and retrieves the lists of credit/debit accounts that the payor has previously registered with the system, and transmits this list back to the PIA..." – e.g. col. 15, lines 32-41), and

display control means for displaying a second authentication image instead of

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the first authentication image displayed on the information processing terminal when the authenticating means verifies that the first authentication image is authentic ("The PIA displays the list of credit/debit accounts to the payor" – e.g. col. 15, lines 42-43 and "information such as the amount of a transaction, the identity of a payee, the list of credit/debit accounts for a payor to select from, or other transaction-related information is displayed using an integrated LCD screen 14..." – e.g. col. 8, line 64 – col. 9, line 2 and please see below examiner's response to argument item 12),

wherein the information processing terminal comprises:

acquisition means for acquiring the first authentication image ("the payor submits a bid biometric sample obtained from their physical person by the PIA's biometric sensor. The PIA determines that the biometric sample is non-fraudulent, and then translates and compresses that biometric sample into a format suitable for rapid transmission to the DPC" – e.g. col. 15, lines 26-31),

second providing means for providing the information management apparatus with the first authentication image, displayed by the display means, through the control device (The DPC identifies the payor using the biometric sample, and retrieves the lists of credit/debit accounts that the payor has previously registered with the system, and transmits this list back to the PIA..." – e.g. col. 15, lines 32-41),

wherein the display means ("an integrated LCD screen 14" in fig. 1) displays the second authentication image instead of the first authentication image when the information management apparatus verifies that the first authentication image

provided by the second providing means is authentic ("The PIA displays the list of credit/debit accounts to the payor" – e.g. col. 15, lines 42-43. Please note the list of credit/debit accounts for a payor to select from corresponds to Applicant's the authentication image since Pare Jr. et al. discloses in col. 15, lines 35-39, "the DPC identifies the payor, and retrieves the list of credit/debit accounts that the payor has previously registered with the system and then displays on the screen").

Pare, Jr. et al. does not disclose expressly that first providing means for providing the information processing terminal with the first authentication image generated by the generating means and display means for displaying the first authentication image acquired by the acquisition means. However, Pare, Jr. et al. discloses "information such as the amount of a transaction, the identity of a payee, the list of credit/debit accounts for a payor to select from, or other transaction-related information is displayed using an integrated LCD screen 14..." – e.g. col. 8, line 64 – col. 9, line 2).

It would have been obvious to a person with ordinary skill in the art at the time of the invention that first providing means for providing the information processing terminal with the first authentication image generated by the generating means and first authentication image (the biometric sample) is transaction-related information, which is displayed using an integrated LCD screen 14.

The motivation of doing so would have been to "assure that any biometric input gathered from the biometric sensor is from a real physical person, instead of a copy or replica", as taught by Pare, Jr. et al. (col. 8, lines 15-17) and helps to "determine the biometric sample is non-fraudulent, and then translates and compresses that biometric



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sample into a format suitable for rapid transmission to the DPC”, as taught by Pare, Jr. et al. (col. 15, lines 28-31)

As per **claim 5**, Pare, Jr. et al. discloses an apparatus as applied above in claim 3. Pare, Jr. et al. further discloses wherein the generating means generates the first authentication image containing first amount information based on a first amount of money already paid by the user (e.g. col. 15, lines 42-61).

As per **claim 6**, Pare, Jr. et al. discloses an information management method as applied above in claim 2. Pare, Jr. et al. further discloses wherein the generating means subtracts an amount spent by the user from the amount represented by the first amount of information when the authenticating means verifies that the first authentication image is authentic, and generates the second authentication image containing a second amount of information based on a resulting remaining amount of money (e.g. col. 15, lines 42-61).

As per **claim 7**, Pare, Jr. et al. discloses an apparatus as applied above in claim 3. Pare, Jr. et al. further discloses wherein the first authentication image and the second authentication image constitute a continuous scene (e.g. col. 8, lines 64-67 and col. 15, lines 42-44. Please note there is no interruption between displaying the first authentication image and the second authentication image. Therefore, they constitute a continuous scene.)

As per **claim 8**, Pare, Jr. et al. discloses an apparatus as applied above in claim 3. Pare, Jr. et al. further discloses wherein each of the first authentication image and the second authentication image is one of a still image and a moving image ("biometric sample" – e.g. col. 15, line 26 and "the list of credit/debit accounts" – e.g. col. 15, lines 42-43 are both still images).

As per **claim 10**, Pare, Jr. et al. discloses the claimed method of steps as applied above in claim 9. Therefore, Pare, Jr. et al. discloses the claimed computer product for carrying out the method of steps.

As per **claims 13-14**, Pare, Jr. et al. discloses a terminal as applied above in claim 11. Pare, Jr. et al. further discloses wherein the first authentication image contains a first amount of information based on a first amount of money already paid by the user and wherein the second authentication image contains a second amount of information based on a remaining amount which is obtained by subtracting an amount spent by the user from the amount represented by the first amount of information (e.g. col. 15, lines 42-61).

As per **claim 15**, Pare, Jr. et al. discloses a terminal as applied above in claim 11. Pare, Jr. et al. further discloses wherein the first authentication image and the second authentication image constitute a continuous scene (e.g. col. 8, lines 64-67 and col. 15, lines 42-44. Please note there is no interruption between displaying the first

authentication image and the second authentication image. Therefore, they constitute a continuous scene.).

As per **claim 16**, Pare, Jr. et al. discloses a terminal as applied above in claim 11. Pare, Jr. et al. further discloses wherein each of the first authentication image and the second authentication image is one of a still image and a moving image (e.g. col. 15, lines 42-61).

As per **claim 18**, Pare, Jr. et al. discloses the claimed method of steps as applied above in claim 17. Therefore, Pare, Jr. et al. discloses the claimed computer program for carrying out the method of steps.

### ***Response to Arguments***

10. Applicant's arguments filed 27 April 2007 have been respectfully and fully considered but they are not persuasive.

11. The Applicant argues on page 11 of the remark, "Pare does not suggest nor render obvious "a generating means for generating a first authentication image based on a predetermined original image", the examiner respectfully disagrees.

Pare discloses "the payor submits a bid biometric sample obtained from their physical person by the PIA's biometric sensor. The PIA determines that the biometric sample is non-fraudulent, and then translates and compresses that biometric sample into a format suitable for rapid transmission to the DPC" – e.g. col. 15, lines 26-31.

Please note "determines that the biometric sample is non-fraudulent" is Pare's abstract

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"...a comparator engine compares the bid biometric sample with at least one **registered biometric sample** for producing for producing either a successful or failed identification of the payor." Clearly, Pare's reference reads on this claim limitation.

12. The Applicant argues on page 12 of the remark, "Pare does not teach, nor would it be physically possible for the Pare system to provide a "second authentication image"...there is a clear distinction between the display of transactional data and "authentication images"....Accordingly, the list of credit/debit accounts from which the payor selects..does not serve to authenticate the payor...", the examiner respectfully disagrees.

First, on page 11 of the remark, even the Applicant's argument of what Pare teaches shows that this limitation is met by Pare. Applicant states "...Pare teaches that the biometric (authentication) information must remain constant between different transactions. This is evident because Pare requires that the payor register a **biometric sample**, which is **associated with a payor's credit card**...Thereafter the payer makes purchase **without "presenting any personalized man-made tokens"**.

Second, in col. 5, lines 5-9, Pare discloses "...a payor **registration** step, wherein the payor **registers** with an **electronic identicator** at least one **registration biometric sample**, and at least one **payor credit/debit account data**. Therefore, contrary to Applicant's statement, Pare does disclose payor credit/debit account data is to serve to authenticate the payor.

Third, for the sake of the argument, Pare also met the claim limitation by disclosing "Information such as ...**the identity of a payee...is displayed** using an integrated LCD screen 14" and in col. 4, lines 45-58, Pare discloses "...wherein the **payee's identification is verified...the payee would registered with the electronic third party identifier payee identification data..a payee hardware ID code, a payee phone number ...a payee email address..a payee account number, a payee biometric....**". Please note image of the identity of a payee is used to authenticate the payee and is corresponding to Applicant's second authentication image.

Fourth, the Applicant's disclosure does not explicitly define "second authentication image". Therefore, the term should be given its broadest reasonable interpretation. The term should not be limited to preferred embodiments in the specification. See *In re ACTV, Inc. v. The Walt Disney Company*, 346 F.3d 1082, 1092, 68 USPQ2d 1516, 1524 (Fed. Cir. 2003) and *In re E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003). (Fed. Cir. 1993). Also, the Applicant is respectfully reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F. 2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. Regarding Applicant's argument on page 12 towards the independent claims 2-3, 9-11, 17 and 18 being allowable due to similar reasons of independent claim 1. However, because the arguments for claim 1 are traversed, these claims are not also allowable. Applicant further argues on page 12 towards the dependent claims 4-8 and

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12-16 being allowable due to dependency. However, because the arguments for the independent claims are traversed, the dependent claims are also not allowable.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

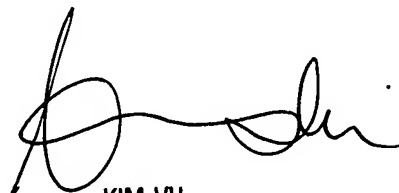
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

13 July 2007  
AYS



KIM VU  
SENIOR PATENT EXAMINER  
TECHNOLOGY CENTER 2100